REMARKS

This amendment is in response to the Examiner's Office Action dated 02/03/2004, and further in view of the interview of 04/26/2004. Applicants are appreciative for the professional and courteous interview held with the examiner. Changes have been made to the claims as discussed during the telephone interview. The amended claims are believed to be in allowable form and this amendment should obviate outstanding issues. Reconsideration of this application is respectfully requested in view of the foregoing amendment and the remarks that follow.

STATUS OF CLAIMS

1.   Claims 1-37 are pending.

2.   Claims 1-4, 9-17, 21-28 and 33-37 are rejected under 35 USC 103(a) as being unpatentable over Xcontact in view of Official Notice.

3.   Claims 5, 7, 8, 19, 20, 29, 31 and 32 are rejected under 35 USC 103(a) as being anticipated by Xcontact in view of Official Notice, in further view of Kennedy et al. U.S.P. 5,831,611.

OVERVIEW OF CLAIMED INVENTION

The present invention provides a system and method that helps a user maintain relationships with other people, i.e., business, professional, and personal contacts. With the system and method of the presently claimed invention, the user does not have to manually search through their contacts and determine whom it is they should contact. Rather, the system automatically searches through the user's contacts and chooses the contact they should get in touch with. The choice is based on criteria indicated by the user through user preferences. This criteria can be, for example, random selection, time since last contact; special dates, etc. The choice(s) made are then displayed to the user, preferably with an image of the person, to indicate

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that the user should contact the person. By automatically choosing a person to contact and displaying that choice to the user, the psychological and time hindrances to maintaining relationships are greatly reduced or overcome.

REJECTIONS UNDER 103(a)

The examiner has rejected claims 1-4, 9-17, 21-28, and 33-37 under U.S.C. §103(a) as being unpatentable over Xcontact in view of official notice. Rejections with respect to claims 3, 16, and 27 are considered moot in view of the current amendment. Furthermore, as per the examiner's suggestion during the interview of 04/26/2004, independent claims 1, 14, and 26 are amended to clarify the merits of applicants' invention.

With respect to claims 1-2, 4, 9-15, 17, 21-26, 28, and 33-37, to establish a *prima facie* case of obviousness under U.S.C. § 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Additionally, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure (In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)). Applicants' contend, as will be shown in the arguments to follow, that the Xcontact reference in view of the examiner's office notice fails to render claims 1-2, 4, 9-15, 17, 21-26, 28, and 33-37 of applicants' invention obvious.

Xcontact is the primary reference used in the rejections of claims 1-2, 4, 9-15, 17, 21-26, 28, and 33-37. Xcontact is a shareware program commensurate with well known address book systems, such as Microsoft™ Outlook®. Xcontact provides the user a way to first enter, then look-up contact information. However, Xcontact does not, either explicitly or implicitly, teach or suggest a system or method for using the contact information stored within to intelligently and automatically remind the user to keep in communication with specific contacts over time, based on pre-stored preferences.

In stark contrast, the applicants' invention provides for a dynamic system and method for renewing business, professional, and personal contacts wherein the invention overcomes time and psychological hindrances to maintaining relationships by automatically selecting whom a user should keep in touch with and by automatically displaying this selection to the user. The system automatically searches a contact list for candidates based on predetermined user preferences and a time-based algorithm (e.g., contact each week, month, 2 weeks after a meeting, etc.). Selected candidates are collected and images transferred to a display module to build a "keep in touch" section to be displayed to the user.

Claims 1, 14, and 26 provide for the limitation of retaining user preferences in computer storage. The examiner asserts that Xcontact provides for "retaining user preferences" in computer storage by referencing "sort functions" on page 4 of the Xcontact reference. However, "sort functions" as used in Xcontact does not refer to preferences, but instead refers to various fields, such as First Name, Name, or Company. By contrast, the term "Preference", as used in applicants' specification and claims define: the type of contact (professional or personal), the time-based frequency of contact in an automatic invocation, the type of selection algorithm, etc.

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(see page7, lines 7+). It should be noted that the "sort functions" of the Xcontact reference merely refers to sorting results after a search is completed. For example, after a user has used the Xcontact software to manually search for a contact name, and if there is more than one result, the Xcontact software can sort the results by "First Name", "Name", or "Company". By contrast, the preferences of applicants' invention are used to automatically search and identify at least one potential contact and not used to sort results of a previously performed search(for example, see claim 1: "automatically searching said list of possible contacts to select a potential candidate based on said user preferences"). Thus, it can be clearly seen that the Xcontact reference fails to provide for the limitation of "retaining user preferences" and selecting "a potential candidate based on said preferences", as required by applicants' specification and claims.

Furthermore, the examiner further contends that the mere mention of "powerful search function" on page 4 of Xcontact equates to the present invention's step of searching a list of contacts to select a potential contact based on user preferences. A closer reading of the Xcontact reference fails to reveal any additional details regarding the "powerful search feature". The examiner is required to provide specifics regarding how Xcontact's "search feature" equates to the claim elements of the present invention. Applicants' are unable to respond with specificity when ambiguous rejections are made based on mere assertions. The term "powerful search feature" does not impart one with knowledge of how the search engine of Xcontact works, and thus does not lead one to the steps necessary to provide for the automatic reminders of potential contacts of the present invention. More specifically, Xcontact does not teach, either explicitly or implicitly, searching a contact list to identify potential contact(s) (whom a user has failed to keep in touch with) based on user preferences. Thus, unless the Examiner is basing his assertion on additional material (that applicants are unaware of) regarding the "powerful search features" of

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Xcontact, applicants contend that the Examiner misinterprets and equates, in error, the step of searching a list of contacts to select a potential contact based on user preferences.

Furthermore, the Examiner equates the step of "retaining potential contacts" selected during a search with the mere mention of the phrase "last search is saved" in Xcontact. Xcontact, on page 4, merely discloses that it retains the last search phrase that was input in a search field of the software. For example, the Figure on page 5 of Xcontact illustrates how the last search phrase "XContact 2.2.1" is retained from a previously entered search. Thus, applicants contend that the Examiner erroneously equates Xcontact's disclosure of retaining the last search entry in memory with the claimed invention's searching and identifying a potential contact.

On page 4 of the office action dated 02/03/2004, the Examiner contends that Xcontact, on page 3, discloses a "time-based request unit" providing an invocation for time-based automatic searching. After a closer reading of the Xcontact reference, Applicants contend that Xcontact merely provides for "alarms" for reminding users regarding important events. For example, users of the Xcontact software could be reminded about a birthday that is approaching. In stark contrast, the time-based request unit that is used in conjunction with a request processor allows for a time-based automatic searching of a list of contacts (wherein searching is based upon preferences) to identify potential contact(s).

The Examiner contends that Xcontact provides all limitations of independent claims 1, 14, and 26 except disclosing the step of automatic searching. Based on the arguments presented above and the arguments presented during the interview of 04/26/2004, applicants, however, disagree that th Xcontact reference provides for many of the limitations of claims 1, 14, and 26.

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Applicants contend, based upon the above mentioned arguments, that the Examiner's failure to equate or render obvious each and every element of independent claims 1, 14, and 26 results in a failure to establish a *prima facie* case of obviousness.

The Examiner further cites *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958), to support the argument that merely providing an automatic means to replace a manual activity is not novel. However, applicants contend that the Examiner has failed to meet the fundamental threshold by not showing how the Xcontact reference provides a manual implementation of the present invention's system and method for dynamically identifying potential contacts based upon pre-defined preferences. More specifically, if the present invention's system and method for dynamically presenting potential contacts were to be performed manually, at least the following steps need to be performed:

a) first, a user must exhaustively view each and every contact in a contact list;

b) secondly, for each contact the user views, the user must then review various preferences (e.g., last contact date, any dates of importance such as birthdays, etc);

c) thirdly, based upon reviewed preferences, the user has to make a decision regarding when he/she needs to initiate contact; and

d) lastly, steps (a)-(c) have to repeated after a predetermined time-period (predetermined by user), so the user can review the contact list to identify additional potential contacts with whom he/she needs to stay in touch.

Even a broad interpretation of the Xcontact reference fails to provide, either explicitly or implicitly, any of or a combination of, the above-mentioned manual steps. Hence, the argument regarding automating a series of searches using Xcontact to identify a potential contact is considered not applicable.

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Additionally, regarding claims 2 and 15, the Examiner contends that Xcontact further discloses user preferences, wherein said user preferences comprise either preferences input by the user (at least page 4 of Xcontact, *browser sample*) or pre-selected default preferences (at least page 4 of Xcontact, *sort functions*). Applicants' have shown in the above-mentioned arguments that Xcontact fails to provide for a system that automatically reminds users regarding persons to keep in touch and Xcontact fails to provide for preferences that are used in automatically searching potential contacts. Applicants' have also shown that the "preferences" of the present invention cannot be equated to the "sort functions" of the Xcontact reference. Page 4 of the Xcontact reference merely shows a GUI displaying contact information (such as Name, Address, phone numbers associated with the contact, e-mail address, and website). There is no teaching, either explicit or implicit, on page 4 regarding how users are able to set preferences, wherein such preferences are used later in automatically searching for potential contacts.

Regarding dependent claims 4-13, 17-15, and 28-37, the Examiner further contends that it would have been obvious to one of ordinary skill in the art to have either modified Xcontact or to have combined Xcontact (or an obvious modification of Xcontact) with Kennedy (5,831,611) to provide for many of the limitations of these dependent claims. Applicants', however, contend that since the examiner has failed to make a *prima facie* case with respect to the independent claims 1, 14, and 26, the obviousness argument with respect to claims 9, 21, and 33 fails in at least that the limitations of their respective independent claims have not been met.

SUMMARY

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As has been detailed above, none of the references, cited or applied, provide for the specific claimed details of applicants' presently claimed invention, nor renders them obvious. It is believed that this case is in condition for allowance and reconsideration thereof and early issuance is respectfully requested.

As this amendment has been timely filed within the set period of response, no petition for extension of time or associated fee is required. However, the Commissioner is hereby authorized to charge any deficiencies in the fees provided to Deposit Account No. 12-0010.

If it is felt that an interview would expedite prosecution of this application, please do not hesitate to contact applicants' representative at the below number.

Respectfully submitted,

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